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10/565,158	01/19/2006	Makoto Akihata	283583US6PCT	7307
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KANAAN, SIMON P	
			ART UNIT 2432	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/565,158	Applicant(s) AKIHATA, MAKOTO	
	Examiner SIMON KANAAN	Art Unit 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/19/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The instant application having Application No. 10565158 filed on January 19, 2006 is presented for examination by the examiner.

Priority

2. As required by M.P.E.P. 201.14(c), acknowledgement is made of applicant's claim for priority based on applications filed on May 19, 2004 (Japan 2004-149492).

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The applicant's drawings submitted are acceptable for examination purposes.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on January 19, 2006 has been acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 13 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter of “content data reproduction program” and “registration confirmation program” which are software, *per se*. The claims lack the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. 101. It is clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. It is at best, function descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because

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“[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, and 5-14 are rejected under 35 U.S.C. 103(a) as being anticipated by Irwin et al. (US PreGrant publication 7,289,273 B2) in view of Stefik (US Patent No: 5,715,403)

As per claim 1, Irwin discloses content data reproduction apparatus for reproducing content data, said content data reproduction apparatus comprising:

- reception means for receiving from said registration confirmation apparatus a registration confirmation signal which informs that said content data reproduction apparatus or said user has been registered; - Irwin, columns 6, lines 1-32, col. 20, lines 23-60; consumer device i.e. repository requests data from an intermediate rights provider registering itself

storage means for storing content data acquired from content data provision apparatus, said content data provision apparatus providing - Irwin, columns 5, lines 40-67, consumer device is an mp3 player which store data

but fails to disclose expressly said content data which is prohibited from being stored in an external section; setting means for setting said content data stored in said storage means to be reproducible when said reception means receives said registration confirmation signal; and reproduction means for reproducing said content data when a reproduction command for said content data is input via an input means while said content data is being set to be reproducible by said setting means.

However, Stefik discloses said content data which is prohibited from being stored in an external section; - Stefik, column 46, line 52 to column 47, line 21, different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section.

setting means for setting said content data stored in said storage means to be reproducible when said reception means receives said registration confirmation signal; - Stefik, column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music.

and reproduction means for reproducing said content data when a reproduction command for said content data is input via an input means while said content data is being set to be reproducible by said setting means. - Stefik, column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music.

Irwin and Stefik are analogous art because they are from the same field of endeavor of electronic digital rights management.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the data reproduction device as described by Irwin and the digital rights management as taught by Stefik in order to implement a DRM for external storage.

As per claim 2, Irwin in view of Stefik discloses The content data reproduction apparatus according to claim 1, wherein when an operation to purchase said content data which is associated with attribute information informing that said content data is prohibited from being stored in an external device is performed, - Stefik, column 46, line 52 to column 47, line 21, different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section.

said content data reproduction apparatus transmits to a content data sales apparatus a purchase notification signal which notifies said content data sales apparatus of an intention to purchase said content data, -Irwin figure 3, consumer device requests play from content server and obtains rights, consumer requests to purchase media and gets updates rights upon receiving signal from license server

and then when receiving from said content data sales apparatus a sale notification signal which notifies said content data reproduction apparatus that a sale of said content data is completed, -Irwin figure 3 teaches the purchased data rights transmitted to consumer device

said content data reproduction apparatus changes said attribute information of said content data such that said attribute information informs that said content data is

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allowed to be stored in an external section. -Stefik, column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music. User gets the right given the choices they make. If they are not paying they would be able to view it only if they pay they would get rights to copy. Once user pays the rights associated with the music are updated to allow user to make copies.

As per claim 3, Irwin in view of Stefik discloses The content data reproduction apparatus according to claim 2, wherein said attribute information informing that said content data is allowed to be stored in an external section shows permission of outputting said content data to an external section as if said content data is lent out, or permission of outputting said content data to an external section as well as deleting said content data from said storage means. -Stefik, column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music. User gets the right given the choices they make. If they are not paying they would be able to view it only if they pay they would get rights to copy. Once user pays the rights associated with the music are updated to allow user to make copies.

As per claim 5, Irwin in view of Stefik discloses The content data reproduction apparatus according to claim 1, further comprising readout means for reading out said content data from a storage medium, wherein said storage means stores said content data read by said readout means. -Stefik, column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music. User gets

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the right given the choices they make. If they are not paying they would be able to view it only if they pay they would get rights to copy. Once user pays the rights associated with the music are updated to allow user to make copies. User being able to view the music file is reading it out.

As per claim 6, Irwin in view of Stefik discloses The content data reproduction apparatus according to claim 1, wherein said content data provided from said content data provision apparatus is associated with attribute information informing that said content data is prohibited from being output to an external section. - Stefik, column 46, line 52 to column 47, line 21, different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section.

As per claim 7, Irwin in view of Stefik discloses The content data reproduction apparatus according to claim 6, further comprising: output means for outputting content data to an external section; and output control means for controlling said output means such that said content data is not output when the attribute information of said content data informs that the outputting of said content data is prohibited. - Stefik, column 46, line 52 to column 47, line 21, different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section. Column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music. User gets the right given the

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choices they make. If they are not paying they would be able to view it only if they pay they would get rights to copy. Once user pays the rights associated with the music are updated to allow user to make copies. User being able to view the music file is reading it out. So Stefik discloses the a digital work can have permission rights associated with it which only allows user to view it and it can have rights to make copies and it can have multiple rights given what user chooses. Hence user can have one right till they make the purchase and their right changes i.e. receive additional rights to the digital media.

As per claim 8, Irwin discloses A registration confirmation apparatus comprising: reception means for receiving from content data reproduction apparatus a confirmation request signal which requests said registration confirmation apparatus to confirm whether or not said content data reproduction apparatus or a user has been registered, - Irwin figure 3, consumer device requests play from content server and obtains rights, consumer requests to purchase media and gets updates rights upon receiving signal from license server

said content data reproduction apparatus capable of reproducing content data; - Irwin, column 19, lines 35 through 52, content device is able to reproduce data

first storage means for storing apparatus identification information identifying said content data reproduction apparatus or user identification information identifying said user, - Irwin, figure 3

but fails to disclose expressly along with payment status information showing payment status of said content data reproduction apparatus or said user; determination

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means for checking said first storage means based on said apparatus identification information or said user identification information shown by the received confirmation request signal to determine whether or not said content data reproduction apparatus or said user has been properly charged; and transmission means for transmitting to said content data reproduction apparatus a registration confirmation signal which informs that said content data reproduction apparatus or said user has been registered, in response to the determination result of said determination means.

However, Stefik discloses along with payment status information showing payment status of said content data reproduction apparatus or said user; determination means for checking said first storage means based on said apparatus identification information or said user identification information shown by the received confirmation request signal to determine whether or not said content data reproduction apparatus or said user has been properly charged;

and transmission means for transmitting to said content data reproduction apparatus a registration confirmation signal which informs that said content data reproduction apparatus or said user has been registered, in response to the determination result of said determination means. - Stefik, columns 27 and 28, repositories communicate insuring other is registered and a message indicating registration is sent

Irwin and Stefik are analogous art because they are from the same field of endeavor of electronic digital rights management.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the data reproduction device as described by Irwin and the digital rights management as taught by Stefik in order to implement a DRM for external storage.

As per claim 9, Irwin in view of Stefik discloses The registration confirmation apparatus according to claim 8, further comprising: second storage means for storing content data; and content data transmission means for transmitting to said content data reproduction apparatus said content data stored in said second storage means, in response to a request from said content data reproduction apparatus. – Irwin figure 3, and Stefik, columns 27 and 28, repositories communicate insuring other is registered and a message indicating registration is sent. There are two repositories which store and transmit the data between them.

As per claim 10, Irwin in view of Stefik discloses The registration confirmation apparatus according to claim 9, wherein said content data transmission means transmits to said content data reproduction apparatus said content data which is prohibited from being stored from said content data reproduction apparatus to an external section. , - Stefik, column 46, line 52 to column 47, line 21, different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section.

As per claims 11 and 13, Irwin discloses A content data reproduction method of content data reproduction apparatus for reproducing content data, said content data reproduction method comprising: a first step of transmitting to registration confirmation apparatus a confirmation request signal which requests the registration confirmation apparatus to confirm whether or not said content data reproduction apparatus or a user has been registered; - Irwin figure 3

But fails to disclose expressly a second step of receiving from said registration confirmation apparatus a registration confirmation signal which informs that said content data reproduction apparatus or said user has been registered; a third step of storing in a storage means content data acquired from content data provision apparatus, said content data provision apparatus providing said content data which is prohibited from being stored in an external section; a fourth step of setting said content data stored in said storage means to reproducible when said registration confirmation signal is received from said registration confirmation apparatus; and a fifth step of reproducing said content data when a reproduction command for said content data is input via an input means while said content data is being set to reproducible.

However Stefik discloses a second step of receiving from said registration confirmation apparatus a registration confirmation signal which informs that said content data reproduction apparatus or said user has been registered; - Stefik, columns 27 and 28, repositories communicate insuring other is registered and a message indicating registration is sent. signal sent informing repository that user is registered

a third step of storing in a storage means content data acquired from content data provision apparatus, said content data provision apparatus providing said content data which is prohibited from being stored in an external section; - Stefik, column 46, line 52 to column 47, line 21, different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section.

a fourth step of setting said content data stored in said storage means to reproducible when said registration confirmation signal is received from said registration confirmation apparatus; - Stefik, column 46, line 52 to column 47, line 21, different rights can be set to digital media. One of the rights can be to only play the file and not be able to copy it hence not be able to store it in an external section.

and a fifth step of reproducing said content data when a reproduction command for said content data is input via an input means while said content data is being set to reproducible. - Stefik, column 48, lines 36 through 54, rights to store/make copies are not granted till user decides to purchase the music.

Irwin and Stefik are analogous art because they are from the same field of endeavor of electronic digital rights management.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the data reproduction device as described by Irwin and and the digital rights management as taught by Stefik in order to implement a DRM for external storage.

As per claims 12 and 14, Stefik discloses A registration confirmation method of registration confirmation apparatus, said registration confirmation a confirmation request signal which requests to confirm whether or not said content data reproduction apparatus or a user has been registered, said content data reproduction apparatus capable of reproducing content data; - Irwin figure 3 and columns 6, lines 1-32, consumer device i.e. repository requests data from an intermediate rights provider registering itself

But fails to disclose expressly a second step of determining whether or not said content data reproduction apparatus or said user has been properly charged by checking a storage means based on apparatus identification information identifying said content data reproduction apparatus or user identification information identifying said user shown in the received confirmation request signal, said storage means storing said apparatus identification information or said user identification information along with payment status information showing payment status of said content data reproduction apparatus or said user; and a third step of transmitting to said content data reproduction apparatus a registration confirmation signal which informs that said content data reproduction apparatus or said user has been registered, in response to the determination result of said second step.

However Stefik discloses a second step of determining whether or not said content data reproduction apparatus or said user has been properly charged by checking a storage means based on apparatus identification information identifying said content data reproduction apparatus or user identification information identifying said

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user shown in the received confirmation request signal, said storage means storing said apparatus identification information or said user identification information along with payment status information showing payment status of said content data reproduction apparatus or said user; - Stefik, column 8, lines 1-33 and figure 3, repositories connecting to credit server which handles payments and sends correct information to repositories informing them whether user is authorized or not.

and a third step of transmitting to said content data reproduction apparatus a registration confirmation signal which informs that said content data reproduction apparatus or said user has been registered, in response to the determination result of said second step. - Stefik, columns 27 and 28, repositories communicate insuring other is registered and a message indicating registration is sent.

Irwin and Stefik are analogous art because they are from the same field of endeavor of electronic digital rights management.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the data reproduction device as described by Irwin and the digital rights management as taught by Stefik in order to implement a DRM for external storage.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Irwin in view of Stefik and in further view of Shimizu et al. (US PreGrant Publication 2005/0071660 A1).

As per claim 4, Irwin in view of Stefik discloses The content data reproduction apparatus according to claim 1,

but fail to disclose expressly wherein said transmission means transmits said confirmation request signal to said registration confirmation apparatus each time when said content data reproduction apparatus is powered on.

However, Shimizu discloses wherein said transmission means transmits said confirmation request signal to said registration confirmation apparatus each time when said content data reproduction apparatus is powered on.

Irwin and Shimizu are analogous art because they are from the same field of endeavor of electronic data management. – Shimizu, page 6, [0119] - [0121], discloses a device which is registered every time it is powered on

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the data reproduction device as described by Irwin and registering the device each time it is powered on as taught by Shimizu because registering the device reduces the likelihood that the device is illicitly copied and dangerous. (Shimizu, [0006]).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Kanaan whose telephone number is (571) 270-3906. The examiner can normally be reached on Monday to Friday 8:30 AM to 5:00 PM.

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If attempts to reach the above noted Examiner by telephone are unsuccessful, the Examiner's supervisor, Gilberto Barron, can be reached at the following telephone number: (571) 272-3799.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SIMON KANAAN/
Examiner, Art Unit 2432

/Gilberto Barron Jr./
Supervisory Patent Examiner, Art Unit 2432